

REMARKS

Applicant wishes to thank the Examiner for the attention accorded to the instant application, and respectfully requests reconsideration of the application as amended.

Formal Matters

Claims 28, 29, 32, and 33 are pending in the application. Claim 28 is amended to recite that the steps of the method are performed on the user equipment. Support for this amendment can be found throughout the specification, including on page 4, lines 1-2 and 13-14, and page 10, lines 6-10. Care has been taken to ensure no new matter is being entered.

Rejection of Claims Under 35 U.S.C. §101

Claim 28 is rejected under 35 U.S.C. § 101 as not falling within one of the four statutory categories of invention. Claim 28 is amended to recite that the steps of receiving first and second lists and storing the first list are performed on user equipment, that is, a mobile communication device or apparatus. Accordingly, claim 28 recites statutory subject matter of an apparatus such as a user equipment of a mobile telephone or other dedicated or combination communication device (see specification page 1, lines 21-26). Withdrawal of this rejection is respectfully requested.

Rejection of Claims Under 35 U.S.C. §103

Claims 28, 29, and 33 are rejected under 35 U.S.C. § 103(a) as unpatentable over Lynch et al., U.S. Patent No. 5,761,618 (hereinafter "Lynch") in view of U.S. Patent No. 6,122,503 to Daly (hereinafter "Daly"). Claim 32 was rejected under 35 U.S.C. §103(a) as unpatentable over Lynch in view of Daly and U.S. Patent No. 6,125,280 to Grandhi et al. (hereinafter "Grandhi"). These rejections should be withdrawn based on the comments and remarks herein.

The present application is related to techniques for handover from an active network to a selected one of a plurality of potential other networks. The present application describes an alternative to scanning broadly for available networks by teaching a User Equipment that is configured to receive a list of networks available for a potential handover, e.g., a first list, from the active network to which the User Equipment is connected (specification, page 10, lines 6-8). The application also discloses a User Equipment that is configured with a list of network preferences, e.g., a second list, which includes preference information regarding, for example, networks which are “black listed” with which the User Equipment is never to be connected, networks which are “white listed” with which communication is preferred, and networks which are “gray listed” with which communication is to be attempted in the absence of a “white listed” network (specification, page 4, lines 12-25). The User Equipment is further configured to *compare* the list of networks available for a potential handover to the list of networks preferences in order to select a network for handover (specification, page 11, lines 9-11).

In the outstanding Office Action, the Examiner alleges that the “preferred SID list” of Lynch reads on the “first list of a plurality of network identifiers that are available for a potential handover, from the communication network while a call is in progress” recited in the claims of the present application. Applicant respectfully disagrees.

Lynch describes a cellular telephone system including subscriber units modified to selectively acquire connection to a service provider during roaming conditions. These service providers are identified by System Identification (SIDs) numbers. Each service provider broadcasts a unique SID. See Lynch, column 1, lines 59-65. A suitably equipped subscriber scans the wireless system operating within proximity to the subscriber unit to determine which service provider is providing service in a physical area to which the subscriber unit has roamed.

Accordingly, *at best* Lynch discloses creating a collection of SIDs or network identifiers based on individually collecting SIDs obtained while scanning the network. Lynch does not teach or suggest “receiving a message that includes a first list including a plurality of network identifiers that are available for potential handover from the communication network” as recited in the claims of the present invention.

Further, both Daly and Grandhi fail to cure the above-described deficiencies of Lynch, and the Examiner does not state otherwise.

It has been held by the courts that to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. See, *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). As illustrated above, the hypothetical combination of Lynch and Daly and Grandhi, taken singly or in any combination, does not disclose or suggest receiving a message including a first list of a plurality of network identifiers available for a potential handover, said receiving from the mobile communication network while a call is in progress, and does not teach or suggest each and every feature of the present invention as recited in claims 28, 29, 32, and 33. Thus *prima facie* obviousness has not been established, so that these claims patentably distinguish over the art of record in the application.

Accordingly, withdrawal of this rejection is respectfully requested.

Conclusion

For at least the reasons set forth in the foregoing discussion, Applicant believes that the Application is now allowable, and respectfully requests that the Examiner reconsider the rejection and allow the Application. Should the Examiner have any questions regarding this

Amendment, or regarding the Application generally, the Examiner is invited to telephone the undersigned attorney.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Katherine R. Vieyra".

Katherine R. Vieyra
Registration No. 47,155

Scully, Scott, Murphy & Presser, P.C.
400 Garden City Plaza, Suite 300
Garden City, New York 11530
(516) 742-4343

KRV:av